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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,964	12/14/2001	Heidi Riedel	Beiersdorf 755-KGB	7321
7055	7590	09/11/2006	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			KANTAMNENI, SHOBHA	
			ART UNIT	PAPER NUMBER
			1617	
DATE MAILED: 09/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,964

Applicant(s)

RIEDEL ET AL.

Examiner

Shobha Kantamneni

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) NONE is/are allowed.
- 6) ☒ Claim(s) 18-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/20/2006.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/20/2006 has been entered.

Applicant's amendment filed on 4/20/2006, canceled claims 1-6, 8-13, and 15-16, and added new claims 18-43.

Applicant's amendment filed on 4/20/2006 wherein claims 1-6, 8-13, and 15-16 have been canceled has overcome the rejection of claims 1-6, 8-13, and 15-16 made in the final office action dated 09/19/2005.

Currently, claims 18-43 are pending in this application, and examined herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to new claims 18-43 has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for the limitation, "emulsifier B selected from polyethoxylated fatty acid having a chain length of from 10-40 carbon atoms and a degree of ethoxylation of from 5 to 100". The original specification discloses "emulsifier B chosen from the group of polyethoxylated fatty acid esters having a chain length of from 10 to 40 carbon atoms and a degree of ethoxylation of from 5 to 100", and not the fatty acids. See page 3, lines 23-26, page 5, lines 8-15.

Note for compact prosecution, claims 18-43 are examined as a cosmetic or dermatological preparation comprising "polyethoxylated fatty acid esters having a chain length of from 10 to 40 carbon atoms and a degree of ethoxylation of from 5 to 100" as emulsifier B, and the following rejections are made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-24, 28-31, 34, 36-39, 42, 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. (FR 2,789,397 with English translation of record).

Bellon et al. exemplify a facial foam composition or preparation comprising 22% PEG-100 stearate glyceryl stearate which is a polyethoxylated fatty acid ester in the instant claim 18 (I)-B: stearate having a chain 18 carbons and 100 of ethoxylation; 12% stearic acid which is a fatty acid in the instant claim 18 (I)-A: stearic acid having a chain 18 carbons; 6% octyldodecanol, which is a fatty alcohol in the instant claim 1 (I)-C having a chain 20 carbons; nitrogen added to the composition in 70% by volume which is one gas in claim 18 (II). See Example 1 and Table 1 (at page 10-11 and 16 of the English translation). The claims therein recite a method of caring for skin comprising applying the composition to the skin. Bellon et al. disclose that the lipid phase in Example 1 which is phase A, is 40.7% of total weight which is obtained from the sum total of phase A (see page 11). Fatty acids such as stearic acid, myristic acid, acids of lauric, cetyl, palmitic, oleic are taught. It is also taught that lipophilic phase that includes the fatty acids represent 30 % of the lipophilic mass, and this lipophilic phase represents 5 % to 25 % by weight of the total composition. See page 5 of the English translation. A gas such as air, nitrogen in the amount of 10 to 90 % by volume of the composition is taught. See page 5 of the English translation. The compositions therein possess properties such as light appearance, good spreading power, quick penetration during use, non-greasy and non-sticky sensation to the skin after application. See page 4 of the English translation. The compositions therein can comprise additional emulsifiers

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such as for example glycerol stearate. See page 13, Example 2. See Example 3, wherein PEG-7 glycerylcocoate is present in an amount of 2.0 %.

Bellon et al. lacks a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight as in claims 18, 42; from 5 % to 15 % as in claims 28 and 37; and from 8 % to 13 % by weight as in claim 29. Bellon et al. do not expressly disclose a ratio of a:b:c of 1:1:1.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the total amounts of a, b, and c, and a ratio of a:b:c of 1:1:1.

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to exemplify a composition wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight as in claims 18, 42; from 5 % to 15 % as in claims 28 and 37; from 8 % to 13 % by weight as in claim 29, using the teachings of Bellon et al. with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

Moreover, the optimization of the ratio of a:b:c based on the prior art teachings, is considered well within conventional skills in pharmaceutical science, involving merely routine skill in the art.

It has been held that it is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

The recitation "wherein the preparation comprises up to 30 % by weight, based on a total weight of the preparation, of a lipid phase comprising one or more nonpolar liquids", and "wherein the preparation comprises up to 40 % by weight, based on a total weight of the preparation, of a lipid phase, of polar liquids" in claims 19-20 reads on 0 % weight of nonpolar liquids, and polar liquids.

Claims 25-27, 32, 33, 40, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bellon et al. as applied to claims 18-24, 28-31, 34, 36-39, 42, 43 above, and further in view of Synder (4,708,813).

Bellon et al. is applied as discussed above.

The reference lacks a hydrophilic emulsifier.

Bellon et al. does not teach the particular alcohols such as cetyl alcohol, and stearyl alcohol in the composition therein.

Synder teaches a nonlathering cleansing mousse with skin conditioning benefits. Sorbitan monostearate is taught as a surfactant that provides skin cleansing benefits and imparts a uniform dispersion of emollient and other ingredients in the composition. Surfactants are disclosed as comprising 1.5-15% of the composition. See abstract; Col. 4, line 26-Co1. 5, line 24. Fatty alcohol foam modifiers, which are C12-C22 saturated chain fatty alcohols, for example cetyl alcohol, stearyl alcohol, lauryl alcohol, and mixtures thereof are taught. It is taught that these fatty alcohol enhance the stability of the mousse, and provide emollient effect on the skin. The fatty alcohols are present in an amount of 1 % to about 4. % in the composition. See column 3, lines 30-45.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the sorbitan monostearate of Synder to the composition of Bellone et al. because of the expectation of achieving a composition with greater skin cleansing benefits and which imparts uniformity to the emulsion.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ fatty alcohols such as cetyl alcohol, stearyl alcohol in the composition of Bellone et al.

One of ordinary skill in the art would have been motivated to employ cetyl alcohol, stearyl alcohol as fatty alcohols with the expectation of obtaining a stable composition which provides emollient effect on the skin as taught by Synder.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bellone et al. as applied to claims 18-24, 28-31, 34, 36, 37-39, 42, 43 above, in view of Saint-Leger et al. (5,939,077).

Bellone et al. is applied as discussed above. The reference lacks carbon dioxide.

Saint-Leger et al. teach cosmetic compositions. Carbon dioxide and nitrogen are taught as interchangeable gases that are used in producing cosmetic foams. See Col. 4, lines 7-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the nitrogen of Bellone et al. for carbon dioxide because Saint-Leger et al. teach carbon dioxide and nitrogen as equivalent gases for use in producing cosmetic foams.

Response to Argument

Applicant's arguments filed on 06/20/2006 with respect to the rejections made under 35 U.S.C. 103(a) of record in the previous Final Office Action dated 09/19/2005 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art as further discussed below.

Applicant argues that "one of ordinary skill in the art is not provided with any motivation whatsoever by BELLON to use a combination of emulsifiers A to C other than the specific combination of Example 1 thereof in any gas-containing cosmetic or dermatological preparation, let alone motivated to optimize the total concentration of emulsifiers A to C recited in the present claims, in particular, to reduce the total concentration thereof in comparison to that of Example 1 of BELLON by at least about 13 % ". This argument has been considered, but not found persuasive as discussed above in the rejection. Further even though Bellon et al. does not exemplify the total amounts of the emulsifiers A, B, and C as instantly claimed, it has been well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). It is respectfully pointed out that Bellon et al. disclose a substantially similar

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emulsifier system to the one claimed herein having all three essential ingredients wherein B and C are in the same amounts as claimed herein, and A can be in an amount such as 22% of PEG-100 stearate glyceryl stearate as in Example 1, and 2 % PEG-7 glycerylcocoate as in Example 3 of English translation. As shown by the Examples in Bellon the amounts of A, B, and C can be varied to obtain the desired properties. Thus, there is clear motivation to optimize parameters such as A, B, and C to obtain the composition with beneficial properties.

Thus, the claimed invention is clearly obvious in view of the cited prior art.

Furthermore, the record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-22, 28-33, 35, 42-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Beutler et al. (US 4,808,388, PTO-1449).

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Beutler et al. discloses foamable cosmetic creams for application onto the skin, comprising oil-in-water emulsion. The composition or preparation therein comprises 2 to 9 % by weight of emulsifying agent such as PEG glyceryl stearate, PEG 9-stearate, cetareth-12 (PEG-12-cetyl stearyl ether), and mixtures thereof; 0.5 to 4.5 % by weight of consistency-providing agent, a combination of cetearyl alcohol and stearic acid; 4.5 to 21 % by weight of oil portion selected from fatty substances such as vegetable and mineral oil, liquid fatty alcohols, and liquid waxes; and gases such as N₂O, CO₂. See column 2, lines 3-10; lines 28-50. A composition comprising 2.0 % by weight of cetareth-12 (PEG-12-cetyl stearyl ether), 1.0 % by weight of cetearyl alcohol, and 2.5 % by weight of stearic acid, and 2 to 3.2 % by weight of a gas such as N₂O, CO₂ is disclosed. See Example 7/2; column 20, claims 1-4. The composition therein comprises a total of 2.5 % to 13.5 % by weight of polyethoxylated fatty acid esters, cetearyl alcohol, and stearic acid. A method of preparing said compositions is also taught.

Thus, Beutler et al. anticipates instant claims 18-22, 28-33, 35, 42-43.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Penksa et al. (EP 0 938 890, PTO-1449, IDS filed on 06/20/2006).

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Penkas et al. discloses skin care compositions containing a liquid, inert, hydrofluorocarbon infused with carbon dioxide. The compositions therein comprise 3 % by weight of stearic acid, 0.5 % by weight of cetyl alcohol, 0.5 % by weight of peg-100 stearate. See paragraphs [0016], [0019], [0072] to [0073], EXAMPLES 6-7. The method of preparing said compositions is also disclosed.

Thus, Penkas et al. anticipates instant claim 42.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-41 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-34, 43 of

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Application 10/469695; claims 16-31, 34-35, 45, 47, 48. of 10/469696; claims 17-32, 35-36, 47-48 of Application 10/469697; claims 14-29, 32-33, 42, 43 of Application 10/469698; claims 13-28, 31-32, 40 of Application 10/469074. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a cosmetic or dermatological preparation comprising emulsifiers A, B, C, wherein the total weight % of emulsifiers A, B, and C is 2 to 20 % by weight, and 1% to 90 % by volume of a gas, and the claims of '695, '696, '697, '698, '074 are drawn to a cosmetic or dermatological composition comprising emulsifiers A, B, C, and 1 % to 90 % by volume of a gas.

Applications '695, '696, 697, 698, 074 lack a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight based on the total weight of the preparation. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amounts and a ratios of A:B:C of 1:1:1 with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

Therefore, the instant claims 18-41 are seen to be obvious over the claims of application '695, '696, '697, '698, '074.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 42 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17 of Application

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10/760088. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are drawn to a method of preparing a self-foaming cosmetic or dermatological preparation comprising a gaseous ingredient, and emulsifiers A, B, C, wherein the total weight % of emulsifiers A, B, and C is 2 to 20 % by weight, and the claims of '088 are drawn to a method of producing a foamable cosmetic or dermatological composition comprising combining a gaseous ingredient with emulsifiers A, B, C, and a gaseous ingredient.

Application '088 lacks a specific exemplification, wherein the total amount of emulsifiers A, B, and C is from 2 % to 20 % by weight based on the total weight of the preparation. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to optimize the amounts and a ratios of A:B:C of 1:1:1 with the expectation of achieving a cosmetically acceptable form of a foam that has a light texture and does not leave a residual greasy or sticky film.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930. The examiner can normally be reached on Monday-Friday, 8am-4pm.

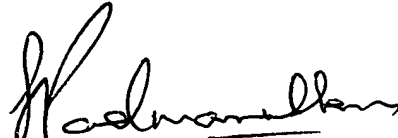
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, Ph.D can be reached on 571-272-0629. The fax

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phone number for the organization where this application or proceeding is assigned is
571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni, Ph.D
Patent Examiner
Art Unit 1617.



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER